

REMARKS

The provisional election of claims 1-12 and 40-43 is affirmed. New claim 45 is added. Claims 1-12 and 40-43 and 45 are presently pending; claims 13-39 and 44 are withdrawn.

Claim 1 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of Application No. 10/763,534. This provisional rejection will be addressed should claim 1 be allowed.

Claims 5-12 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed, and the Examiner's attention is directed to page 4, lines 1-14 of the present application. Claim 7 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. As described on page 4, lines 5 and 6, of the present application, the "liquid chocolate ingredient may be in the form of a gel." Thus, this rejection is respectfully traversed.

Claims 1-12 and 40-43 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,471,689 to Piana in view of U.S. Patent No. 6,698,228 to Kateman et al. It is respectfully submitted that claims 1-12 and 40-43 are not unpatentable over Piana in view of Kateman.

Piana does not disclose a cartridge for use in a beverage preparation machine contain a beverage ingredient that is a liquid chocolate ingredient. To the contrary, Piana discloses a cartridge containing "powdery or granular matters, such as blends of powdered cocoa and powdered milk for the preparation of hot chocolate beverage." (Col. 2, ll. 47-50.) Piana also states that its "invention relates to a disposable cartridge...which contains a dose of water-soluble granular, powdery or similar particulate matter..." (Col. 1, ll. 9-12.)

There is no motivation identified in the Office action in either Piana or Kateman for their proposed combination. In fact, Piana teaches away from its use with a liquid product by stating that it is directed to a cartridge that purports to address deficiencies with prior cartridges for "freeze-dried or other water soluble products..." (Col. 1, l. 57 – col. 2, l. 4.)

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Amendment dated April 3, 2007
Reply to the Office action of November 3, 2006

The Commissioner is hereby authorized to charge any additional fees which may be required in this application to Deposit Account No. 06-1135.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

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